

REMARKS

I. General

Claims 1-12 are pending in the present application. Applicant notes with appreciation that claim 8 is indicated by the Examiner as containing allowable subject matter. Claims 1-7 and 9-12 stand rejected under 35 U.S.C. § 103. Claims 1-12 stand rejected under the judicially created doctrine of double patenting. The drawings and the specification stand objected to. Applicant respectfully traverses the rejections and objections of record.

Claim 8 has been amended to include the limitations of base claim 1 and intervening claim 7. Accordingly, claim 8 has been amended to recite the limitations of the base claim and any intervening claims from which it depends. As such, claim 8 is asserted to be patentable over the art of record.

II. The Objections to the Drawings

The drawings stand objected to because they do not include certain identified reference signs mentioned in the specification. The drawings further stand objected to because they include certain identified reference signs not mentioned in the specification.

With respect to reference numeral 901 identified in the Office Action as being mentioned in the description without appearing in the drawings, Applicant has amended the two paragraphs of page 41 in which reference numeral 901 appeared. Accordingly, it is respectfully asserted that the objection to the drawings based upon reference numeral 901 not appearing therein should be withdrawn.

With respect to reference numeral 1401A identified in the Office Action as being mentioned in the description without appearing in the drawings, Applicant has amended the paragraph appearing at page 63 to delete reference numeral 1401A and insert therefor reference numeral 1404A. Accordingly, it is respectfully asserted that the objection to the drawings based upon reference numeral 1401A not appearing therein should be withdrawn.

With respect to reference numeral 308 of Figure 3A identified in the Office Action as not being mentioned in the description, Applicant has amended the paragraph appearing at page 25 to insert reference numeral 308. Accordingly, it is respectfully asserted that the

objection to the drawings based upon reference numeral 308 not being mentioned in the description should be withdrawn.

With respect to reference numeral 1404A identified in the Office Action as not being mentioned in the description, as discussed above Applicant has amended the paragraph appearing at page 63 to insert reference numeral 1404A. Accordingly, it is respectfully asserted that the objection to the drawings based upon reference numeral 1404A not being mentioned in the description should be withdrawn.

The drawings further stand objected to because Figure 8 does not depict the traffic light icon disclosed in the paragraph at page 40. In response, Applicant has amended this paragraph to delete reference to a traffic light icon.

Applicant notes that the objection to the drawings will not be held in abeyance and, accordingly, that proposed drawing corrections are required in response to the drawing objections. However, as Applicant has redressed the identified drawing objections through amendments to the specification, it is respectfully asserted that proposed drawing corrections are not necessary in response to the outstanding Office Action.

III. The Objections to the Specification

The specification stands objected to as requiring updated information with respect to the continuing data on page 1 and the application data on pages 1, 2, 29, 30 and 66. In response, Applicant has amended the paragraphs appearing at pages 1, 29, 30, and 66, in which reference to patent applications has been made, to include updated data. The portion of the paragraph continuing from page 1 onto page 2 has not been amended herein as no updated data is applicable.

The specification further stands objected to because it lacks specific reference to particular identified reference numerals present in the drawings. With respect to reference numerals 308 and 1404A identified by the Examiner, Applicant has redressed these objections as set forth above with reference to the drawing objections.

The Office Action identifies reference numeral 1301 as not being referenced with

respect to Figure 13. Applicant has amended the paragraph at page 58 discussing Figure 13 to include reference to reference numeral 1301.

The Office Action states that there is no discussion of how the disclosed program proceeds from box 1020 if the inquiry is “yes.” Applicant has amended the paragraph at page 50 discussing box 1020 to expressly state that the program proceeds to box 1021 when the inquiry is resolved in the affirmative.

With respect to reference numeral 1031, the Office Action states that there is no discussion of how the program proceeds from box 1031 if the inquiry is “no.” Applicant has amended the paragraph at page 50 discussing box 1031 to state that no processing is performed on the postage button if the inquiry is resolved in the negative.

The Office Action states that there is no discussion of how the disclosed program proceeds from box 1034 if the inquiry is “yes.” Applicant has further amended the paragraph at page 50 to state that processing proceeds to step 1036 if the inquiry of box 1034 is resolved in the affirmative.

The Office Action purports to set forth an error perceived by the Examiner with respect to page 21, lines 8-16, and page 24, line 25, through page 25, line 8. However, Applicant’s attorney has reviewed the identified portion of the specification and is unable to identify an error. Applicant respectfully solicits specific guidance as to what part of this portion of the specification is objectionable to the Examiner.

With respect to page 30, line 25, through page 31, line 5, the reference to “portable processor button 19” has been corrected to read “portable processor button 18,” as is consistent with FIGURE 1A. Regarding the objection to the specification based upon the paragraph appearing at page 63, lines 6-15, Applicant has amended the paragraph in redressing the drawing objections as discussed above.

The foregoing amendments do not add new matter to the specification. Moreover, it is respectfully asserted that the foregoing amendments redress the objections of record with respect to the specification. Accordingly, Applicant request that the objections to the specification be withdrawn.

IV. The Double Patenting Rejection

Claims 1-12 stand rejected under the judicially created doctrine of double patenting over claims 1-47 of United States patent number 6,233,568. The judicially created doctrine of double patenting is grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. See M.P.E.P. § 804. Under the provisions of 35 U.S.C. § 154(a)(2), the present application will expire upon the same date as U.S. Patent No. 5,992,936. Accordingly, the policy of improper timewise extension is not implicated with respect to this reference. Therefore, Applicant respectfully asserts that the present application should not be the subject of a rejection based upon the judicially created doctrine of double patenting.

V. The 35 U.S.C. § 103 Rejections

Claims 1-7 and 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Piccione, United States patent number 4,495,581 (hereinafter *Piccione*), or Barns-Slavin et al., United States patent number 5,117,346 (hereinafter *Barns-Slavin*), or Theil, European patent publication number 0805422 (hereinafter *Theil EP*), or Theil, United States patent number 5,699,258 (hereinafter *Theil US1*), or Theil, United States patent number 6,035,291 (hereinafter *Theil US2*), or Theil, United States patent number 6,321,214 (hereinafter *Theil US3*), in view of Berson et al., United States patent number 6,039,257 (hereinafter *Berson*). Applicant respectfully traverses the 35 U.S.C. § 103 rejection of record.

A. The Rejection of Record Does Not Comport With Office Policy

The present Office Action presents 6 alternative prior art rejections of all of the rejected claims by applying 7 different references. While Applicants appreciate the Examiner conducting a comprehensive search of the applicable prior art (in accordance with M.P.E.P. § 904.03), the Examiner is respectfully reminded that:

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's *disclosure* to avoid the citation of an unnecessary number. The examiner is not called upon to cite *all* references that may be available, but only the "best." (37 C.F.R. 1.104(c).) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided. The examiner must fully consider all the prior art references cited in the application, including those cited by the applicant in a properly submitted Information Disclosure Statement. The best reference

should always be the one used. M.P.E.P. § 904.03.

“Prior art rejections should ordinarily be confined strictly to the best available art.” M.P.E.P. § 706.02. “Merely cumulative rejections . . . should be avoided.” M.P.E.P. § 706.02. Also, M.P.E.P. § 707.07(g) directs that the “examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references” (emphasis added). Given that the Office Action sets forth such a large number of alternative claim rejections, Applicants respectfully submit that the Office Action fails to set forth what the Examiner believes to be the best rejection(s).

B. The Rejection of Record Does Not Address All Claim Elements

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must, *inter alia*, teach or suggest all the claim limitations, see M.P.E.P. § 2143. However, the 35 U.S.C. § 103 rejection of record does not address every claim limitation and, therefore, a *prima facie* case of obviousness has not been established.

Independent claim 1 recites “determining a value of said transaction associated with two or more of said plurality of providers [and] presenting each of said determined values for comparison” Similarly, independent claim 9 recites “means for determining a value of said transaction associated with two or more of said plurality of providers [and] means for presenting each of said determined values for comparison” In rejecting these claims, the Office Action merely states that *Piccione* or *Barnes-Slavin* or *Theil EP* or *Theil US1* or *Theil US2* or *Theil US3* “disclose determining the lowest cost carrier for an item to be shipped based on user entered shipping transaction parameters,” the Office Action at page 7. The Office Action further states that *Berson* “discloses using accounting information to generate a multidimensional barcode for the validation of a postage indicia,” *id.* However, neither of these statements regarding the content of the prior art address the above identified aspect of the claims which provide for presenting each of the determined values for comparison. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 1-7 and 9-12.

Moreover, the proffered combination of any of *Piccione* or *Barnes-Slavin* or *Theil EP* or *Theil US1* or *Theil US2* or *Theil US3* and *Berson* does not meet the claims. Claim 1 recites “printing authorization information acceptable by said particular provider in conducting said

transaction.” Similarly, claim 9 recites “means for generating authorization information acceptable by said particular provider in conducting said transaction, wherein said authorization information includes data from which said particular provider may verify prepayment of said transaction value.” However, *Berson* appears to teach only a postage indicia according to the United States Postal Service information based indicia program (IBIP). Accordingly, the proffered modification to the primary references would provide authorization information acceptable only to a United States Postal Service carrier. Accordingly, claims 1-7 and 9-12 are asserted to be patentable over the 35 U.S.C. § 103 rejections of record.

C. The Rejection of Record Does Not Provide the Requisite Motivation

To establish a *prima facie* case of obviousness, there must be, *inter alia*, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, see M.P.E.P. § 2143. The Office Action concedes that none of *Piccione* or *Barnes-Slavin* or *Theil EP* or *Theil US1* or *Theil US2* or *Theil US3* do not disclose printing an authorized indicia for an item to be shipped based on user entered shipping transaction parameters, see the Office Action at page 7. The Office Action seeks to cure this deficiency in the primary references by introducing *Berson*, stated to disclose using accounting information to generate a multidimensional barcode for the validation of a postage indicia. The motivation set forth in the Office Action for modifying any of the primary references to include the postage indicia printing of *Berson* is that “[s]ince, the carrier wants to be paid for service rendered to the user, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping system of [the primary references] could be modified to print an authorization indicia as taught by *Berson*,” *id.* However, because *Berson* appears to teach only a postage indicia according to the United States Postal Service information based indicia program (IBIP), the carriers other than a United States Postal Service carrier would not be paid by the resulting system. Accordingly, proper motivation for one of ordinary skill in the art to modify the primary references in view of *Berson* as proffered is not present.

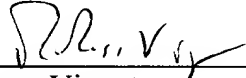
VI. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. According, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P000C2CP1C1/10106029 from which the undersigned is authorized to draw.

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Respectfully submitted,

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